

- A¹ Cancel*
- b. from about 0.1% to about 30%, by weight of the composition, of a PVP copolymer selected from the group consisting of tricontanyl PVP copolymer, PVP/hexadecane copolymer, and mixtures thereof; and
 - c. from about 0.1% to about 30%, by weight of the composition, of at least one resin.

- A²*
23. (Amended) The cosmetic composition of Claim 1 that is a mascara product that further comprises a component selected from the group consisting of cosmetic fillers, cosmetic preservatives, and mixtures thereof.

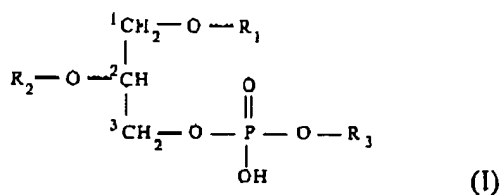
REMARKS

Upon entry of this amendment, Claims 1-25 stand rejected and Claims 1-4 and 6-25 remain pending in the present application. Claim 1 has been amended to recite more preferred PVP copolymers in the claimed composition. Support for this amendment can be found in Applicants' Specification at Page 6, line 8, Page 7, lines 1 and 7, and Claim 5 as originally filed. Claim 23 has been amended to clarify the constitution of Applicants' claimed composition. Claim 5 has been cancelled without prejudice. No new matter has been added.

Invention Synopsis

The present invention relates to cosmetic compositions having improved application benefits to keratinous tissue and keratinous fibers wherein said compositions have improved application benefits, while avoiding the negatives associated with compositions currently known in the art. The compositions of the present invention can comprise the following components either before or after mixing:

- a. from about 0.1% to about 5% of a phospholipid having the formula



in which R₁ represent C₁₀₋₂₀ acyl, R₂ represent hydrogen or C₁₀₋₂₀ acyl, R₃ represent hydrogen, 2-trimethylamino-1-ethyl, 2-amino-1-ethyl, C₁₋₄ alkyl, C₁₋₅ alkyl substituted by carboxy, C₂₋₅ alkyl substituted by hydroxy, C₂₋₅ alkyl substituted by carboxy and hydroxy or C₂₋₅ alkyl substituted by carboxy and amino, the inositol group or the glyceryl group, or salts of these compounds;

- b. from about 0.1% to about 30%, by weight of the composition, of a PVP copolymer selected from the group consisting of tricontanyl PVP copolymer, PVP/hexadecane copolymer, and mixtures thereof; and
- c. from about 0.1% to about 30%, by weight of the composition, of at least one resin.

FORMAL MATTERS

REJECTION UNDER 35 USC §112, 2nd Paragraph


Claim 4 has been rejected under 35 USC §112, 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner states that the term "free oil" is vague and indefinite. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the term "free oil" is sufficiently definite and reasonably describes the claimed technology to those skilled in the art so that they may make and use the invention. Whether a claim is invalid or unpatentable for indefiniteness depends on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the specification. *North Am. Vaccine, Inc. v. American Cyanamid Co.*, 28 USPQ2d 1333, 1339 (Fed. Cir. 1993); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ 2d 1081, 1088 (Fed. Cir. 1986). One having ordinary skill in the art would understand "free oil" to mean that which is the residual portion of the lecithin that is not a phospholipid. Skilled Artisans use the term "free oil" for the residual portion although that portion may or may not contain oil. When read in light of the specification, the scope of the claim is well understood. See Applicants' Specification, Page 5, lines 10-11. Applicants, therefore, submit that the phrase is clear. Consequently, it is respectfully submitted that the rejection under 35 USC §112, 2nd paragraph, as to Claim 4, line 3, has been overcome and should be reconsidered and withdrawn. JM

Claim 23 has been rejected under 35 USC §112, 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner states that it is not clear whether the claim requires both cosmetic fillers and preservatives, or recites alternative limitations. Applicants respectfully traverse this rejection.

Applicants have amended Claim 23 to read "a mascara product that further comprises a component selected from the group consisting of cosmetic fillers, cosmetic preservatives, and mixtures thereof." The amended language, therefore, clarifies the context of the mascara product of Applicants' invention. In light of the amendment, it is respectfully submitted that the rejections as to this claim be reconsidered and withdrawn.

REJECTION UNDER 35 USC §102

Claims 1-7, 9, 12-14, 16-19, and 21-25 have been rejected under 35 USC §102(a) and (e) as being anticipated by Cannell et al., USP 6,221,389 (hereinafter "Cannell"). The Examiner states that Cannell discloses a mascara composition comprising 0.133 wt% of lecithin, 1.5 wt% of PVP/eicosene copolymer, and 10 wt% of resin solution in water and, therefore, meets the limitations of Applicants' Claims 1-3, 5, 12-14, 24 and 25. Further, the Examiner believes that Claims 9, 16-19, 22, and 23 are met by the mascara formula in Cannell which discloses glyceryl stearate, waxes, iron oxide, disodium cocoamphodipropionate, and paraben preservatives are in the formulation. The Examiner also states that Claim 4 is met by the disclosure that the formulation uses ALCOLEC F-100 powdered lecithin, which is viewed as oil free. Additionally, the Examiner states that Claims 6 and 7 are met based on the information that the resin solution used in the mascara formula in Cannell is AVALURE UR450, which is polyester-polyurethane latex. Applicants respectfully traverse this rejection. 

Anticipation can only be established when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.* 221 USPQ 385, 388 (Fed. Cir. 1984). Thus, there must be no difference between the claimed invention and the disclosure relied upon as anticipatory, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Res. Found. v. Genentech Inc.*, 927 F2d 565, 18 USPQ2d 1001 (CAFC 1991).

Cannell discloses a composition containing at least one organic phospholipid capable of forming bilayers in aqueous solution; at least one amphoteric surfactant; and at least one nonionic surfactant present in an amount by weight equal to or greater than the amount of the phospholipid. The reference, however, fails to teach or suggest Applicants' claimed invention comprising from about 0.1% to about 5%, by weight of the composition, of a phospholipid, from about 0.1% to about 30%, by weight of the composition, of a PVP copolymer selected from the group consisting of tricontanyl PVP copolymer, PVP/hexadecane copolymer, and mixtures thereof; and from about 0.1% to about 30%, by weight of the composition, of a resin. Specifically, the general disclosure in Cannell that is pointed out by the Office fails to teach or suggest how each ingredient may be combined in specific amounts, such as those presently claimed, to provide a long wearing, film-forming cosmetic product with improved aesthetic attributes. Lastly, Cannell fails to teach or suggest Applicants' specific PVP copolymers as presently claimed. Applicants have found that the polymers specifically recited contribute to an improved film-forming attribute of the claimed composition. Applicants respectfully submit that a reference disclosure that is generic to or suggestive of a claimed product does not preclude patentability of the product if the product possesses one or more significant properties that are not shared by its closest counterpart(s) within the disclosed or suggested genus, or if the claimed product is significantly better (with regard to a

material property) than its closest counterpart(s) within the disclosed or suggested genus. *In re Ruschig, Aumuller, Korger, Wagner, Scholz, and Bänder*, 343 F.2d 965, 145 USPQ 274, 281, 283 (C.C.P.A. 1965); *In re Krazinski, Shepherd, and Taft*, 347 F.2d 656, 146 USPQ 25, 29, 30 (C.C.P.A. 1965); *In re Fay and Fox*, 347 F.2d 597, 146 USPQ 47, 50 (C.C.P.A. 1965); *In re Petrzilka, Hofmann, Schenk, Troxler, Frey, and Ott*, 424 F.2d 1102, 165 USPQ 327, 328, 329 (C.C.P.A. 1970); *In re Waymouth and Koury*, 499 F.2d 1273, 182 USPQ 290, 292, 293 (C.C.P.A. 1974). Cannell, therefore, fails to teach each and every element of Applicants' claimed invention. Absent a teaching or suggestion of each and every element, there can be no finding that Applicants' claimed invention is anticipated. Reconsideration and withdrawal of the rejection under 35 USC §102(a) and (e) is respectfully requested.

REJECTION UNDER 35 USC §103

Claims 1-25 have been rejected under 35 USC §103(a) as being unpatentable over Bartholomey, US 5,614,200 (hereinafter "Bartholomey") in view of Cannell. The Examiner states that Bartholomey teaches mascara compositions comprising lecithin, which meets the limitations of claims 1(a) and 2-4; and ammonia acrylate copolymer which meets the limitations of claims 1(c) and 6-8. Additionally, the Examiner states that the addition of film forming agents such as PVP and PVP/VA copolymers is suggested in Bartholomey, meeting claim 1(b). Further, the Examiner asserts that the weight ratio of glycerol monostearate to lecithin as required by claims 10-11 have been disclosed in Bartholomey. The Examiner concedes that Bartholomey fails to teach the specific type of PVP copolymers in claim 5 but states that Cannell teaches PVP/eicosene copolymers. Thus, the Examiner believes that due to the general teaching of using film-forming agents such as PVP/copolymers in mascara formulation in Bartholomey, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have looked to prior art such as Cannell for specific types of the copolymers conventionally used in the art. Applicants respectfully traverse this rejection.

how?
show
Bartholomey discloses a composition which comprises from about 20% to about 65% solids; from about 20% to about 80% liquid vehicle; and from about 8% to about 50% a setting rate which delays the setting of the composition long enough to provide sufficient time to distribute the mascara in semi-liquid form onto the lashes as well as contribute to lash-thickening properties while avoiding negative aesthetics. Thus, the formulations disclosed therein provide lash separation and application ease at the expense of wear (i.e., smearing and water resistance). The reference, however, fails to teach or suggest each and every limitation of Applicants' claimed cosmetic composition that provides lash thickening, separation, and detangling in combination with long wear. Although Bartholomey generally discloses a PVP copolymer as an optional ingredient, it fails to teach the necessity of the claimed amount of Applicants' specific PVP copolymers in combination with Applicants' claimed range of lecithin and resin

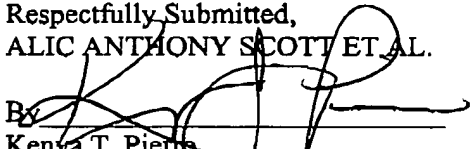
that provides the benefits of aesthetic improvements and longevity. Assuming arguendo that one having ordinary skill in the art would possibly combine the disclosures of Bartholomey and Cannell, one would still fall short of Applicants' claimed invention only to arrive at a composition containing a phospholipid, an amphoteric surfactant, a nonionic surfactant, glycerol monostearate and possibly a PVP copolymer.

why not? { The mention of a PVP copolymer in an example in either reference would not motivate one skilled in the art to use Applicants' particular PVP copolymers in an amount as presently claimed in combination with a resin and the hypothetical composition above. In particular, the hypothetical composition would not include from about 0.1% to about 5%, by weight of the composition, of Applicants' phospholipid component, from about 0.1% to about 30%, by weight of the composition, of a PVP copolymer selected from the group consisting of tricontanyl PVP copolymer, PVP/hexadecane copolymer, and mixtures thereof; and from about 0.1% to about 30%, by weight of the composition, of a resin so that one having ordinary skill in the art would be able to read the disclosure and understand how to make and use such invention. Since neither reference mandates the use of Applicants' specifically claimed PVP copolymers in combination with a lecithin and resin, one reading the disclosures of both Bartholomey and Cannell would not have been motivated to combine the references in order to arrive at the presently claimed invention. In fact, a skilled artisan reading such disclosures would not have appreciated and understood the essential nature of including such elements that make up Applicants' claimed invention for improved aesthetic attributes and longevity. The hypothetical composition, therefore, fails to teach or suggest each and every element of Applicants' presently claimed invention. Since one would not have been motivated to combine the disclosure of Bartholomey with the disclosure of Cannell, the cosmetic composition of the present invention cannot be rendered as obvious. In light of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 USC §103(a). This is 4) 50V

CONCLUSION

In view of the above, Applicants respectfully submit that each of the issues raised by the Examiner has been addressed. Reconsideration and allowance of each of the pending claims is therefore respectfully requested.

Respectfully Submitted,
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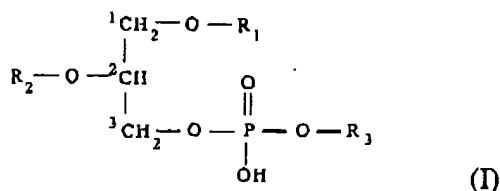
VERSION WITH MARKINGS SHOWING CHANGES MADE

Please cancel Claim 5.

Please amend Claims 1 and 23 to read as follows:

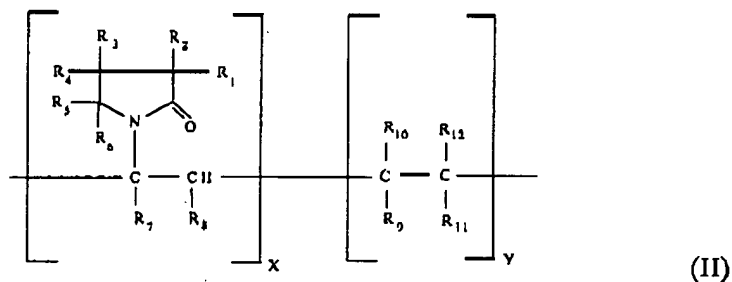
1. (Amended) A cosmetic composition comprising:

a. from about 0.1% to about 5% of a phospholipid having the formula



in which R₁ represent C₁₀₋₂₀ acyl, R₂ represent hydrogen or C₁₀₋₂₀ acyl, R₃ represent hydrogen, 2-trimethylamino-1-ethyl, 2-amino-1-ethyl, C₁₋₄ alkyl, C₁₋₅ alkyl substituted by carboxy, C₂₋₅ alkyl substituted by hydroxy, C₂₋₅ alkyl substituted by carboxy and hydroxy or C₂₋₅ alkyl substituted by carboxy and amino, the inositol group or the glyceryl group, or salts of these compounds;

b. from about 0.1% to about 30%, by weight of the composition, of a PVP copolymer selected from the group consisting of tricontanyl PVP copolymer, PVP/hexadecane copolymer, and mixtures thereof [at least one PVP-copolymer having the formula:



in which the radicals R₁-R₁₂ represent, independently of each other, a straight or branched C₁₀-C₄₀ alkyl radical, or a hydrogen atom, at least of said radicals R₁-R₁₂ being different from the hydrogen atom, Y can be equal to or greater than zero and X must not be equal to zero]; and

c. from about 0.1% to about 30%, by weight of the composition, of at least one resin.

23. (Amended) The cosmetic composition of Claim 1 that is a mascara product that further comprises a component selected from the group consisting of cosmetic fillers, cosmetic preservatives, and mixtures thereof.